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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,889	03/31/2004	Ori Gerstel	100101-000300US	9087
37490	7590	11/25/2008	EXAMINER	
Trellis Intellectual Property Law Group, PC 1900 EMBARCADERO ROAD SUITE 109 PALO ALTO, CA 94303			ENG, DAVID Y	
			ART UNIT	PAPER NUMBER
			2455	
			NOTIFICATION DATE	DELIVERY MODE
			11/25/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/815,889	<b>Applicant(s)</b> GERSTEL ET AL.	
	<b>Examiner</b> DAVID Y. ENG	<b>Art Unit</b> 2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-15,21,22,24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,21,22,24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/29/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 2, 16-20, 23, 25 have been cancelled. The active claims are 1, 3-15, 21-22, 24 and 26-27 of which claims 1, 21-22 and 24 are independent claims.

In view of the amendment, the Section 101 Rejection and the Section 112, 2<sup>nd</sup> paragraph Rejection are withdrawn.

#### ***Claim Rejections - 35 USC § 112/ 1<sup>st</sup> par.***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-15, 21-22, 24 and 26-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to disclose a network planning tool being used prior to a time of operation of the digital network to define a recommended route as claimed. The planning tool is essential to practice the claimed invention. Without the planning tool, one of ordinary skill in the art would not be able to make and use the invention without undue experiments.

## **Response**

In respond to the Section 112, 1<sup>st</sup> Rejection, Applicants agree in the response filed on 9/29/2008 that "Cisco MetroPlanner" referenced in the specification is not for defining a recommended route. Applicants argued that the specification teaches how to use traditional planning tools such as the Cisco MetroPlanner to define a recommended route and then allocating the recommended route at the time of operation of the digital network. However, Applicants fail to and the Examiner is unable to identify the support of how to use the well known tools such as the Cisco MetroPlanner to define a recommended route. Applicants identify page 1-9 of the Cisco MetroPlanner for the support. However, there is no page1-9 in the Cisco MetroPlanner. The Cisco MetroPlanner is indexed by chapters and sections. Applicants are invited to review the copy via PAIR and to identify the chapter, the sections and subsections therein. Applicants are further requested to identify the support in the specification as to how to use the well known tools such as the Cisco MetroPlanner to define a recommended route at the time of operation of a digital network which Applicants rely on for patentability.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 3, 5-13, 21-22, 24 and 26**

Claims 1, 3, 5-13, 21-22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) in view of Applicant's admitted prior art The MetroPlanner <sup>TM</sup> by Cisco described in [16].

***Claim Rejections - 35 USC § 103***

**Claims 4, 27**

Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) and Applicant's admitted prior art The MetroPlanner <sup>TM</sup> by Cisco described in [16] further in view of Moure (USP 7,219,159).

***Claim Rejections - 35 USC § 103***

**Claims 14, 15,**

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) and Applicant's admitted prior art The MetroPlanner <sup>TM</sup> by Cisco described in [16] further in view of Garfinkel (USP 5,408,600).

Details of the rejections have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

**Response**

Applicants contended that Blouin does not disclose any use of a planning tool or network planning information. Applicants agree that Blouin is concerned with analysis of routes at a time of operation of the network (Applicants' emphases, page 7, 1<sup>st</sup>

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paragraph) in order to allocate a route. Applicants further agree that that the Cisco MetroPlanner teaches how to define a recommended route and then allocating the recommended route at the time of operation of the digital network (Examiner's emphasis, page 6, 3<sup>rd</sup> paragraph). Applicants further admitted that the function of defining a recommended route was well-known to network planners at the time of filing the present application in order to design network traffic routes at a planning stage (Applicants' emphasis, page 6, 2<sup>nd</sup> last paragraph). The Examiner rely on the Cisco MetroPlanner and not Blouin for the teaching of defining a recommended route at a planning stage (prior to a time of operation of the digital network) as admitted by Applicants. The Blouin is relied on by the Examiner for the teaching of creating a route list listing a plurality of routes so that the best available route from the route list can be chosen at a time of operation of the digital network when a route is needed.

Further with respect to Applicants' remarks, Applicants fail to provide arguments as to why the limitations "prior to a time of operation" and "at a time of operation of a digital network" would render the claim invention patentable distinct over the applied prior art.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID Y. ENG/

Primary Examiner, Art Unit 2455